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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,210	07/28/2003	Daniel G. Brady	27556	5311

7590 06/22/2005

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EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/629,210	BRADY ET AL.	
	Examiner	Art Unit	
	Paul B. Prebilic	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 31-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 31-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/4/04 + 6/2/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

The information disclosure statement filed October 4, 2004 fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statement filed June 2, 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. For this reason, the foreign language patent has been struck from the PTO-1449 and has not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-10, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Peyman et al (US 6,197,057). Peyman anticipates the claim language where the primary lens as claimed is met by the intraocular lens already implanted of Peyman, and the supplemental lens as claimed is the supplemental lens of Peyman et al; see the abstract, column 9, lines 7-42, and column 5, line 64 to column 6, line 4.

Regarding claim 7, Applicants are directed to Figure 21 and column 8, lines 42-59 where Peyman discloses an embodiment where the supplemental lens is anteriorly vaulted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman (US 6,197,057) in view of Patel (US 5,366,502). Peyman meets the claim language as explained supra but fails to use of a multifocal or toric diffractive lens as claimed. However, Patel teaches that such lenses were known; see column 8, lines 1-10. Therefore, it is the Examiner's position that it would have been obvious to use an multifocal or toric lens in the Peyman invention for the same reasons that Patel uses the same and in order to enable near and far vision (via a multifocal lens) and to aid a patient with an astigmatism (via a toric lens).

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman et al (US 6,197,057) in view of Portney (US 6,197,058) or Nordan et al (US 2003/0097176). Peyman meets the claim language as explained in the Section 102 rejection above, but fails to teach the thickness of the diffractive supplemental lens as claimed. However, Portney (see column 7, lines 59-62) and Nordan (see abstract) both

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teach that lens thicknesses of less than 250 microns were known. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to make the Peyman supplemental lens less than 250 microns thick for the same reasons as the secondary references, and in order to make the lens insertable through a small incision.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman et al (US 6,197,057) in view of Copeland et al (US 2002/0042653).

Peyman meets the claim language as explained in the Section 102 rejection above but fails to teach a blue blocker or tint feature as claimed. However, Copeland teaches that it was known to incorporate blue blocking or tint into intraocular lenses prior to the invention of the Applicants' invention; see the abstract. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to incorporate blue blocker or tint into the lens of Peyman for the same reasons that Copeland does the same, that is, to achieve maximum visual acuity.

Claims 31 and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman et al (US 6,197,057) in view of Cohen (US 4,881,805). Peyman meets the claim language as explained in the Section 102 rejection *supra* but fails to describe the details of the diffractive lens embodiment, and thus, fails to disclose the use of positive powered lenses, echelettes, and the diffraction profile. However, Cohen teaches that it was known to make diffractive intraocular lenses that are positively powered, that include echelettes, and that have first or multi-ordered profiles as claimed; see column 1, lines 15-23 and see column 1, line 59 to column 2, line 1. Therefore, it is the Examiner's position that it would have been obvious to provide a

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diffractive supplemental lens having the characteristics disclosed by Cohen for the same reasons Cohen uses the same and in order to make wide variety of lenses suitable for many different patients.

Regarding claim 35, the echelettes of the formula of column 1, line 65 are on the order of a wavelength of light in size. For this reason, they would not be visible to the naked eye since they are so small.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman (US 6,197,057) in view of Cohen (US 5,117,306). Peyman fails to disclose a negative lens with echelettes as claimed. However, Cohen ('306) teaches that diffractive lenses including echelettes with both positive and negative lens surfaces were known to the art as a means to prevent chromatic aberration; see column 3, lines 6-16. Therefore, it is the Examiner's position that it would have been obvious to make the negative lens portion of the Peyman device with a negative powered diffractive lens of echelettes for the same reasons that Cohen uses diffractive echelettes as opposed to a refractive surface or to enable the lens to have more than one focal length on the same lens surface.

Response to Arguments

Applicant's arguments filed March 4, 2005 have been fully considered but they are not persuasive.

In response to Applicants' argument that Peyman does not teach a diffractive lens to modify vision correction, the Examiner disagrees and asserts that the intent of

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Peyman is clearly to correct vision. In one embodiment, Peyman discloses using a diffractive lens to accomplish this. The argument that the lenses of Peyman are not enabling for diffractive lenses constitutes a mere allegation since there is no proof thereof. Since the ability to make diffractive intraocular lenses is notoriously old to the art, it is the Examiner's position that one skilled in the art would be able to make the lenses suggested by Peyman without undue experimentation.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure

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outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
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